



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Linda Morales et al. § Art Unit: 2616
Serial No.: 09/960,008 §
Filed: September 21, 2001 § Examiner: Warner Wong
For: Method and Apparatus to § Atty. Dkt. No.: NRT.0103US
Control Handoff Between § (13837RRUS02U)
Different Wireless Systems §

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

Independent claim 1 was rejected as being obvious over the asserted combination of Grob and Dolan. It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 1 over the asserted combination of Grob and Dolan, for at least the following reason: no motivation or suggestion existed to combine the teachings of the references. *See* M.P.E.P. § 2143 (8th ed., Rev. 3), at 2100-135.

With respect to claim 1, the Office Action conceded that Grob fails to disclose the following elements of claim 1: in response to determining that handoff is required, sending a message from the first base station to the second base station, the message indicating to the second base station that handoff is required. 4/24/2006 Office Action at 2. The Office Action, however, relied upon Dolan as disclosing this claim element. *Id.* Specifically, the Office Action pointed to Fig. 6 of Dolan, which shows a source base station sending a source transfer request to

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an MSC, which in turn forwards the source transfer request to a target base station, for the purpose of performing a handoff.

It is respectfully submitted that a person of ordinary skill in the art would not have been motivated to modify the handoff mechanism taught by Grob with the mechanism disclosed by Dolan to achieve the claimed subject matter. Although Grob states that handoffs between CDMA and HDR systems are possible, the handoff performed in Grob is quite different from the handoff performed according to claim 1. As discussed in Grob, when an access terminal 110 is near an edge of the coverage area of an HDR access point 120, the access point 120 can signal the access terminal 110. Grob, 24:27-29. This causes the access terminal 110 to search for both an HDR system access point 120 and CDMA base station. Grob, 24:29-32. If a CDMA pilot is detected by the access terminal 110, then the air link can be handed from the HDR system to the CDMA system, "for example, in a manner similar to the handoff between IS-95 and AMP systems." Grob, 24:32-35.

Thus, what is contemplated by Grob is that a base station of a first type has to notify the access terminal (not the base station of the other type) that handoff may be required, which causes the access terminal to search for available HDR and CDMA base stations. Clearly, Grob does not disclose or suggest base stations of different types sending a message between each other to indicate that handoff is required.

Recognizing this deficiency of Grob, the Office Action turned to Dolan in an attempt to address the deficiencies of Grob. However, it is clear from the teachings of Dolan that its handoff is performed in the context of base stations that operate according to the *same* wireless communications protocol, such as CDMA. There is absolutely no teaching or suggestion in Dolan that its source base station and target base station (as depicted in Fig. 6 as well as in the other figures) are of different types. A person looking to the teachings of Dolan would thus not have been motivated to apply its teachings to the handoff mechanism of Grob.

As purportedly supporting the obviousness rejection, the Office Action further cited *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). However, rather than follow the mandate set forth in *In re Fine*, the Office Action has instead employed impermissible hindsight in making the obviousness rejection. See *In re Fine*, 837 F.2d at 1075 ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

Here, there clearly did not exist any reason to modify the mechanism of Grob using the teachings of Dolan. The Office Action stated that the “motivation for combining the teachings is to provide support [of handoff] for a call to a multi-vendor, customized wireless telecommunications network [as that of Grob’s network], where different protocol types being supported by different base stations are elaborated in Dolan paragraph 41 as handoffs [sic] types supported by base stations, for example, handoffs between IS-95 and AMPS systems” 4/24/2006 Office Action at 9-10. The motivation cited by the Office Action does not support the combination of Grob and Dolan. Note that Grob already discloses a technique for performing handoff between different types of systems, a CDMA system and an HDR system. There existed absolutely no desirability to modify the techniques described in Grob with the techniques described in Dolan, particularly because Dolan relates to performing handoffs within the *same* wireless network, not different types of wireless networks. Since there existed no desirability to modify the teachings of Grob based on the teachings of Dolan, it is respectfully submitted that the Office Action has clearly failed to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) (“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the *desirability* of the modification.”) (emphasis added).

Moreover, the Office Action is proposing a modification of the Grob handoff mechanism that would significantly change the principle of operation of the Grob. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” M.P.E.P. § 2143.02, at 2100-138. Here, as noted above, the handoff mechanism disclosed by Grob involves a base station of a first type notifying an access terminal (not the base station of the other type) that handoff may be required, which causes the access terminal to search for available HDR and CDMA base stations. Modifying the Grob system based on the teachings of Dolan would significantly change the principle of operation of the handoff mechanism of Grob, which is a clear indication that no motivation or suggestion existed to combine Grob and Dolan.

In view of the foregoing, it is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 1.

Independent claims 16 and 24 are allowable for similar reasons.

Dependent claims are allowable for at least the same reasons as corresponding independent claims.

In view of the foregoing, it is respectfully requested that the final rejections of the claims be withdrawn. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0103US).

Respectfully submitted,

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